

PATENT COOPERATION TREATY

From the INTERNATIONAL SEARCHING AUTHORITY

To:
ANWAR IMAM
HICKMAN PALERMO TRUONG & BECKER LLP
2055 GATEWAY PLACE, SUITE 550
SAN JOSE, CA 95110-1089

PCT

NOTIFICATION OF TRANSMITTAL OF
THE INTERNATIONAL SEARCH REPORT AND
THE WRITTEN OPINION OF THE INTERNATIONAL
SEARCHING AUTHORITY, OR THE DECLARATION

(PCT Rule 44.1)

Date of mailing **11 JUL 2008**
(day/month/year)

Applicant's or agent's file reference
60097-0401

FOR FURTHER ACTION See paragraphs 1 and 4 below

International application No.
PCT/US06/24688

International filing date
(day/month/year) 23 June 2006 (23.06.2006)

Applicant
TIVO INC.

1. ☒ The applicant is hereby notified that the international search report and the written opinion of the International Searching Authority have been established and are transmitted herewith.

Filing of amendments and statement under Article 19:

The applicant is entitled, if he so wishes, to amend the claims of the international application (see Rule 46):

When? The time limit for filing such amendments is normally two months from the date of transmittal of the international search report.

Where? Directly to the International Bureau of WIPO, 34 chemin des Colombettes
1211 Geneva 20, Switzerland, Facsimile No.: (41-22) 338.82.70.

For more detailed instructions, see the notes on the accompanying sheet.

2. ☐ The applicant is hereby notified that no international search report will be established and that the declaration under Article 17(2)(a) to that effect and the written opinion of the International Searching Authority are transmitted herewith.
3. ☐ With regard to the protest against payment of (an) additional fee(s) under Rule 40.2, the applicant is notified that:
- ☐ the protest together with the decision thereon has been transmitted to the International Bureau together with the applicant's request to forward the texts of both the protest and the decision thereon to the designated Offices.
 - ☐ no decision has been made yet on the protest; the applicant will be notified as soon as a decision is made.

4. Reminders

Shortly after the expiration of **18 months** from the priority date, the international application will be published by the International Bureau. If the applicant wishes to avoid or postpone publication, a notice of withdrawal of the international application, or of the priority claim, must reach the International Bureau as provided in Rules 90bis.1 and 90bis.3, respectively, before the completion of the technical preparations for international publication.

The applicant may submit comments on an informal basis on the written opinion of the International Searching Authority to the International Bureau. The International Bureau will send a copy of such comments to all designated Offices unless an international preliminary examination report has been or is to be established. These comments would also be made available to the public but not before the expiration of 30 months from the priority date.

Within **19 months** from the priority date, but only in respect of some designated Offices, a demand for international preliminary examination must be filed if the applicant wishes to postpone the entry into the national phase until **30 months** from the priority date (in some Offices even later); otherwise, the applicant must, within **20 months** from the priority date, perform the prescribed acts for entry into the national phase before those designated Offices.

In respect of other designated Offices, the time limit of **30 months** (or later) will apply even if no demand is filed within 19 months.

See the Annex to Form PCT/IB/301 and, for details about the applicable time limits, Office by Office, see the *PCT Applicant's Guide*, Volume II, National Chapters and the WIPO Internet site.

Name and mailing address of the ISA/US
Mail Stop PCT, Attn: ISA/US
Commissioner for Patents
P.O. Box 1450
Alexandria, Virginia 22313-1450
Facsimile No. (571) 273-3201

Authorized officer
James Sheldeneha
Telephone No. (703) 308-HELP

Form PCT/ISA/220 (January 2004)

(See notes on accompanying sheet)

DOCKETED
4/17/08
8/11/08, 9/11/08 - Art. 19 Amend. Due
8/11/08, 10/11/08 - Art. 34 Amend. Due

PATENT COOPERATION TREATY

PCT

INTERNATIONAL SEARCH REPORT

(PCT Article 18 and Rules 43 and 44)

| | | |
|---|---|--|
| Applicant's or agent's file reference 60097-0401 | FOR FURTHER ACTION see Form PCT/ISA/220 as well as, where applicable, item 5 below. | |
| International application No. PCT/US06/24688 | International filing date (day/month/year) 23 June 2006 (23.06.2006) | (Earliest) Priority Date (day/month/year) 22 June 2006 (22.06.2006) |
| Applicant TIVO INC. | | |

This international search report has been prepared by this International Searching Authority and is transmitted to the applicant according to Article 18. A copy is being transmitted to the International Bureau.

This international search report consists of a total of 2 sheets.

☐

It is also accompanied by a copy of each prior art document cited in this report.

1. Basis of the Report

- a. With regard to the **language**, the international search was carried out on the basis of:

☒

the international application in the language in which it was filed.

☐

a translation of the international application into _____, which is the language of a translation furnished for the purposes of international search (Rules 12.3(a) and 23.1(b))

- b. ☐ This international search report has been established taking into account the **rectification of an obvious mistake** authorized by or notified to this Authority under Rule 91 Rule 43.6 *bis(a)*

- c. ☐ With regard to any **nucleotide and/or amino acid sequence** disclosed in the international application, see Box No. I.

2. ☐ **Certain claims were found unsearchable** (See Box No. II)

3. ☐ **Unity of invention is lacking** (See Box No. III)

4. With regard to the **title**,

☒

the text is approved as submitted by the applicant.

☐

the text has been established by this Authority to read as follows:

5. With regard to the **abstract**,

☒

the text is approved as submitted by the applicant.

☐

the text has been established, according to Rule 38.2(b), by this Authority as it appears in Box No. IV. The applicant may, within one month from the date of mailing of this international search report, submit comments to this Authority.

6. With regard to the **drawings**,

- a. the **figure of the drawings** to be published with the abstract is Figure No. _____

☐

as suggested by the applicant.

☐

as selected by this Authority, because the applicant failed to suggest a figure.

☐

as selected by this Authority, because this figure better characterizes the invention.

☒

none of the figures is to be published with the abstract.

INTERNATIONAL SEARCH REPORT

International application No.

PCT/US06/24688

A. CLASSIFICATION OF SUBJECT MATTER

IPC: H04N 7/16(2006.01)
H04N 7/16(2006.01)

USPC: 725/135

According to International Patent Classification (IPC) or to both national classification and IPC

B. FIELDS SEARCHED

Minimum documentation searched (classification system followed by classification symbols)

U.S. : 725/135

Documentation searched other than minimum documentation to the extent that such documents are included in the fields searched

Electronic data base consulted during the international search (name of data base and, where practicable, search terms used)

C. DOCUMENTS CONSIDERED TO BE RELEVANT

| Category * | Citation of document, with indication, where appropriate, of the relevant passages | Relevant to claim No. |
|------------|---|-----------------------|
| X | US 6,008,802 A (Iki et al.) 28 December 1999 (28.12.1999), column 3, line 57-column 8, line 56. | 1-98 |

☐ Further documents are listed in the continuation of Box C.☐ See patent family annex.

* Special categories of cited documents:

"A" document defining the general state of the art which is not considered to be of particular relevance

"E" earlier application or patent published on or after the international filing date

"L" document which may throw doubts on priority claim(s) or which is cited to establish the publication date of another citation or other special reason (as specified)

"O" document referring to an oral disclosure, use, exhibition or other means

"P" document published prior to the international filing date but later than the priority date claimed

"T" later document published after the international filing date or priority date and not in conflict with the application but cited to understand the principle or theory underlying the invention

"X" document of particular relevance; the claimed invention cannot be considered novel or cannot be considered to involve an inventive step when the document is taken alone

"Y" document of particular relevance; the claimed invention cannot be considered to involve an inventive step when the document is combined with one or more other such documents, such combination being obvious to a person skilled in the art

"&" document member of the same patent family

Date of the actual completion of the international search
23 May 2008 (23.05.2008)

Date of mailing of the international search report

11 JUL 2008

Name and mailing address of the ISA/US
Mail Stop PCT, Attn: ISA/US
Commissioner for Patents
P.O. Box 1450
Alexandria, Virginia 22313-1450
Facsimile No. (571) 273-3201

Authorized officer

James Shelcheda

Telephone No. (703) 308-HELP

PATENT COOPERATION TREATY

From the
INTERNATIONAL SEARCHING AUTHORITY

To:
ANWAR IMAM
HICKMAN PALERMO TRUONG & BECKER LLP
2055 GATEWAY PLACE, SUITE 550
SAN JOSE, CA 95110-1089

PCT

WRITTEN OPINION OF THE INTERNATIONAL SEARCHING AUTHORITY

(PCT Rule 43bis.1)

Date of mailing
(day/month/year) **11 JUL 2008**

Applicant's or agent's file referencee

60097-0401

FOR FURTHER ACTION

See paragraph 2 below

International application No.

PCT/US06/24688

International filing date (day/month/year)

23 June 2006 (23.06.2006)

Priority date (day/month/year)

22 June 2006 (22.06.2006)

International Patent Classification (IPC) or both national classification and IPC

IPC: **H04N 7/16** (2006.01) **H04N 7/16** (2006.01)

USPC: 725/135

Applicant

TIVO INC.

1. This opinion contains indications relating to the following items:

- ☒ Box No. I Basis of the opinion
- ☐ Box No. II Priority
- ☐ Box No. III Non-establishment of opinion with regard to novelty, inventive step and industrial applicability
- ☐ Box No. IV Lack of unity of invention
- ☒ Box No. V Reasoned statement under Rule 43bis.1(a)(i) with regard to novelty, inventive step or industrial applicability; citations and explanations supporting such statement
- ☐ Box No. VI Certain documents cited
- ☐ Box No. VII Certain defects in the international application
- ☐ Box No. VIII Certain observations on the international application

2. FURTHER ACTION

If a demand for international preliminary examination is made, this opinion will be considered to be a written opinion of the International Preliminary Examining Authority ("IPEA") except that this does not apply where the applicant chooses an Authority other than this one to be the IPEA and the chosen IPEA has notified the International Bureau under Rule 66.1bis(b) that written opinions of this International Searching Authority will not be so considered.

If this opinion is, as provided above, considered to be a written opinion of the IPEA, the applicant is invited to submit to the IPEA a written reply together, where appropriate, with amendments, before the expiration of 3 months from the date of mailing of Form PCT/ISA/220 or before the expiration of 22 months from the priority date, whichever expires later.

For further options, see Form PCT/ISA/220.

3. For further details, see notes to Form PCT/ISA/220.

Name and mailing address of the ISA/US
Mail Stop PCT, Attn: ISA/US
Commissioner for Patents
P.O. Box 1450
Alexandria, Virginia 22313-1450
Facsimile No. (571) 273-3201

Date of completion of this opinion

23 May 2008 (23.05.2008)

Authorized officer

James Shelecheda

Telephone No. (703) 308-HELP

Form PCT/ISA/237 (cover sheet) (April 2007)

WRITTEN OPINION OF THE
INTERNATIONAL SEARCHING AUTHORITY

International application No.

PCT/US06/24688

Box No. 1 Basis of this opinion

1. With regard to the **language**, this opinion has been established on the basis of:

- ☒ the international application in the language in which it was filed
☐ a translation of the international application into _____, which is the language of a translation furnished for the purposes of international search (Rules 12.3(a) and 23.1(b)).

2. ☐ This opinion has been established taking into account the **rectification of an obvious mistake** authorized by or notified to this Authority under Rule 91 (Rule 43bis.1(a)).

3. With regard to any **nucleotide and/or amino acid sequence** disclosed in the international application, this opinion has been established on the basis of:

a. type of material

- ☐ a sequence listing
☐ table(s) related to the sequence listing

b. format of material

- ☐ on paper
☐ in electronic form

c. time of filing/furnishing

- ☐ contained in the international application as filed.
☐ filed together with the international application in electronic form.
☐ furnished subsequently to this Authority for the purposes of search.

4. ☐ In addition, in the case that more than one version or copy of a sequence listing and/or table(s) relating thereto has been filed or furnished, the required statements that the information in the subsequent or additional copies is identical to that in the application as filed or does not go beyond the application as filed, as appropriate, were furnished.

5. Additional comments:

WRITTEN OPINION OF THE
INTERNATIONAL SEARCHING AUTHORITY

International application No.
PCT/US06/24688

Box No. V Reasoned statement under Rule 43 bis.1(a)(i) with regard to novelty, inventive step or industrial applicability; citations and explanations supporting such statement

1. Statement

| | | |
|-------------------------------|--|-----|
| Novelty (N) | Claims <u>3, 4, 23, 24, 43, 44, 63, 64, 82 and 83</u> | YES |
| | Claims <u>1-2, 5-22, 25-42, 45-62, 65-81 and 84-98</u> | NO |
| Inventive step (IS) | Claims <u>NONE</u> | YES |
| | Claims <u>1-98</u> | NO |
| Industrial applicability (IA) | Claims <u>1-98</u> | YES |
| | Claims <u>NONE</u> | NO |

2. Citations and explanations:

Please See Continuation Sheet

WRITTEN OPINION OF THE
INTERNATIONAL SEARCHING AUTHORITY

International application No.
PCT/US06/24688

Supplemental Box

In case the space in any of the preceding boxes is not sufficient.

V. 2. Citations and Explanations:

A) Claims 1-2, 5-22, 25-42, 45-62, 65-81 and 84-98 lack novelty under PCT Article 33(2) as being anticipated by Iki et al. (Iki) (6,008,802).

As to claims 1, 21 and 41, Iki discloses a method, and corresponding apparatus and computer readable medium, for processing in-band data at a multimedia device (Fig. 1; column 2, lines 53-67), comprising:
receiving a multimedia content stream (column 3, line 57-column 4, line 6), wherein the multimedia content stream contains in-band data (column 4, line 59-column 5, line 2 and column 6, lines 15-35);
processing the in-band data (column 5, lines 3-26);
determining whether a portion of the in-band data matches a particular pattern among a plurality of patterns (column 5, lines 3-26), wherein the particular pattern is associated with one or more events in the multimedia content stream (Fig. 3; column 4, lines 47-58, column 5, line 11-column 6, line 62); and
identifying one or more events in the multimedia content stream based on metadata associated with the matched particular pattern (column 5, line 57-column 6, line 51).

As to claims 2, 22 and 42, Iki discloses wherein the in-band data is closed-caption data (column 5, lines 27-34).

As to claims 5, 25 and 45, Iki discloses in response to identifying one or more events in the multimedia content stream, displaying an icon to a user on a display screen as the multimedia content stream is displayed to a user (column 6, lines 35-51).

As to claims 6, 26 and 46, Iki discloses in response to recognizing one or more events in the multimedia content stream, storing one or more segments of the multimedia content stream on the multimedia device that are related to the one or more recognized events (column 5, lines 47-column 6, line 6).

As to claims 7, 27 and 47, Iki discloses wherein the multimedia content stream further comprises one or more video programs (column 3, lines 57-column 4, lines 7), and wherein the recognizing step recognizes one or more events in the one or more video programs (column 5, lines 10-45).

As to claims 8, 28 and 48, Iki discloses wherein the determining step further comprises processing metadata associated with the matched particular pattern (column 5, line 11-column 7, line 39).

**WRITTEN OPINION OF THE
INTERNATIONAL SEARCHING AUTHORITY**

International application No.
PCT/US06/24688

Supplemental Box

In case the space in any of the preceding boxes is not sufficient.

As to claims 9, 29 and 49, Iki discloses wherein the metadata instructs the multimedia device to perform an action (column 5, line 47-column 7, line 15).

As to claims 10, 30 and 50, Iki discloses wherein the metadata instructs the multimedia device to skip over a segment of the multimedia content stream (column 5, line 54-column 6, line 6).

As to claims 11, 31 and 51, Iki discloses wherein the metadata instructs the multimedia device to re-order two or more segments of the multimedia content stream (column 5, line 54-column 6, line 6).

As to claims 12, 32 and 52, Iki discloses creating, at the multimedia device, a customized multimedia content stream containing the two or more re-ordered segments (column 5, line 54-column 6, line 6); and displaying the customized multimedia content stream to a user (column 5, line 54-column 6, line 6).

As to claims 13, 33 and 53, Iki discloses wherein metadata associated with the identified location instructs the multimedia device to store one or more segments of the content stream on a storage device (column 5, line 46-column 6, line 6), and wherein the storage device contains one or more extracted segments from one or more different content streams (column 5, line 46-column 6, line 6).

As to claims 14, 34 and 54, Iki discloses creating, at the multimedia device, a customized multimedia content stream containing any combinations of segments stored on the storage device (column 5, line 46-column 6, line 6); and displaying the customized content stream to a user (column 5, line 46-column 6, line 6).

As to claims 15, 35 and 55, Iki discloses wherein a user can skip to an identified event (column 5, line 46-column 6, line 6).

As to claims 16, 36 and 56, Iki discloses receiving event identification data associating one or more patterns of in-band data with one or more events (column 6, lines 15-51); and storing the received event identification data on a storage device as part of the plurality of patterns (column 6, lines 15-51).

As to claims 17, 37 and 57, Iki discloses wherein the storage device is a hard disk drive (Fig. 8; column 8, lines 5-56).

As to claims 18, 38 and 58, Iki discloses wherein the storage device is any type of removable storage media (column 6, lines 15-35 and column 8, lines 5-56).

As to claims 19, 39 and 59, Iki discloses wherein the storage device is any type of volatile and/or non-volatile storage medium (column 6, lines 15-35 and column 8, lines 5-56).

As to claims 20, 40 and 60, Iki discloses wherein the multimedia content stream is a television broadcast stream (column 3, line 56-column 4, line 6).

As to claims 61 and 80, Iki discloses a method, and corresponding apparatus, for processing in-band data at a multimedia device (Fig. 1; column 2, lines 53-67), comprising:
receiving a multimedia content stream (column 3, line 57-column 4, line 6) from a removable storage medium (column 3, lines 12-18 and column 5, line 57-column 6, line 6), wherein the multimedia content stream contains in-band data (column 4, line 59-column 5, line 2 and column 6, lines 15-35);

processing the in-band data (column 5, lines 3-26);

determining whether a portion of the in-band data matches a particular pattern among a plurality of patterns (column 5, lines 3-26), wherein the particular pattern is associated with one or more events in the multimedia content stream (Fig. 3; column 4, lines 47-58, column 5, line 11-column 6, line 62); and

identifying one or more events in the multimedia content stream based on metadata associated with the matched particular pattern (column 5, line 57-column 6, line 51).

As to claims 62 and 81, Iki discloses wherein the in-band data is closed-caption data (column 5, lines 27-34).

As to claims 65 and 84, Iki discloses in response to identifying one or more events in the multimedia content stream, displaying an icon to a user on a display screen as the multimedia content stream is displayed to a user (column 6, lines 35-51).

As to claims 67 and 85, Iki discloses wherein the multimedia content stream further comprises one or more video programs (column 3, lines 57-column 4, lines 7), and wherein the recognizing step recognizes one or more events in the one or more video programs (column 5, lines 10-45).

As to claims 68 and 86, Iki discloses wherein the determining step further comprises processing metadata associated with the matched particular pattern (column 5, line 11-column 7, line 39).

WRITTEN OPINION OF THE
INTERNATIONAL SEARCHING AUTHORITY

International application No.
PCT/US06/24688

Supplemental Box
In case the space in any of the preceding boxes is not sufficient.

As to claims 69 and 87, Iki discloses wherein the metadata instructs the multimedia device to perform an action (column 5, line 47-column 7, line 15).

As to claims 70 and 88, Iki discloses wherein the metadata instructs the multimedia device to skip over a segment of the multimedia content stream (column 5, line 54-column 6, line 6).

As to claims 71 and 89, Iki discloses wherein the metadata instructs the multimedia device to re-order two or more segments of the multimedia content stream (column 5, line 54-column 6, line 6).

As to claims 72 and 90, Iki discloses creating, at the multimedia device, a customized multimedia content stream containing the two or more re-ordered segments (column 5, line 54-column 6, line 6); and displaying the customized multimedia content stream to a user (column 5, line 54-column 6, line 6).

As to claims 73 and 91, Iki discloses wherein metadata associated with the identified location instructs the multimedia device to store one or more segments of the content stream on a storage device (column 5, line 46-column 6, line 6), and wherein the storage device contains one or more extracted segments from one or more different content streams (column 5, line 46-column 6, line 6).

As to claims 74 and 92, Iki discloses creating, at the multimedia device, a customized multimedia content stream containing any combinations of segments stored on the storage device (column 5, line 46-column 6, line 6); and displaying the customized content stream to a user (column 5, line 46-column 6, line 6).

As to claims 75 and 93, Iki discloses wherein a user can skip to an identified event (column 5, line 46-column 6, line 6).

As to claims 76 and 94, Iki discloses receiving event identification data associating one or more patterns of in-band data with one or more events (column 6, lines 15-51); and storing the received event identification data on a storage device as part of the plurality of patterns (column 6, lines 15-51).

As to claims 77 and 95, Iki discloses wherein the storage device is a hard disk drive (Fig. 8; column 8, lines 5-56).

As to claims 78 and 96, Iki discloses wherein the storage device is any type of removable storage media (column 6, lines 15-55 and column 8, lines 5-56).

As to claims 79 and 97, Iki discloses wherein the storage device is any type of volatile and/or non-volatile storage medium (column 6, lines 15-55 and column 8, lines 5-56).

As to claims 80 and 98, Iki discloses wherein the multimedia content stream is a television broadcast stream (column 3, line 56-column 4, line 6).

B) Claims 3, 4, 23, 24, 43, 44, 63, 64, 82 and 8 lack an inventive step under PCT Article 33(3) as being obvious over Iki.

As to claims 3, 23, 43, 63 and 82, while Iki discloses in band data within a television signal, he fails to specifically disclose Enhanced Television (ETV) signaling data.

It would have been obvious to utilize Enhanced Television (ETV) signaling data with Iki's interactive television system, as ETV is a well known standard for providing interactivity within a television program.

As to claims 4, 24, 44, 64 and 83, while Iki discloses comparing closed caption data to a particular pattern, he fails to specifically disclose computing hash values from the closed caption data and comparing hash values.

It would have been obvious to include computing and comparing hash values with Iki's interactive television system, as hash values provide a fast method of comparing and searching data by creating and utilizing codes which are much smaller than the original data, thus requiring less storage and processing.

NOTES TO FORM PCT/ISA/220 (continued)

The letter must indicate the differences between the claims as filed and the claims as amended. It must, in particular, indicate, in connection with each claim appearing in the international application (it being understood that identical indications concerning several claims may be grouped), whether

- (i) the claim is unchanged;
- (ii) the claim is cancelled;
- (iii) the claim is new;
- (iv) the claim replaces one or more claims as filed;
- (v) the claim is the result of the division of a claim as filed.

The following examples illustrate the manner in which amendments must be explained in the accompanying letter:

1. [Where originally there were 48 claims and after amendment of some claims there are 51]:
"Claims 1 to 29, 31, 32, 34, 35, 37 to 48 replaced by amended claims bearing the same numbers, claims 30, 33 and 36 unchanged; new claims 49 to 51 added."
2. [Where originally there were 15 claims and after amendment of all claims there are 11]:
"Claims 1 to 15 replaced by amended claims 1 to 11."
3. [Where originally there were 14 claims and the amendments consist in cancelling some claims and in adding new claims]:
"Claims 1 to 6 and 14 unchanged; claims 7 to 13 cancelled; new claims 15, 16 and 17 added" or
"Claims 7 to 13 cancelled; new claims 15, 16 and 17 added; all other claims unchanged."
4. [Where various kinds of amendments are made]:
"Claims 1-10 unchanged; claims 11 to 13, 18 and 19 cancelled; claims 14, 15 and 16 replaced by amended claim 14, claim 17 subdivided into amended claims 15, 16 and 17; new claims 20 and 21 added."

"Statement under Article 19(1)" (Rule 46.4)

The amendments may be accompanied by a statement explaining the amendments and indicating any impact that such amendments might have on the description and the drawings (which cannot be amended under Article 19(1)). The statement will be published with the international application and the amended claims.

It must be in the language in which the international application is to be published.

It must be brief, not exceeding 500 words if in English or if translated into English.

It should not be confused with and does not replace the letter indicating the differences between the claims as filed and as amended. It must be filed on a separate sheet and must be identified as such by a heading, preferably by using the words "Statement under Article 19(1)."

It may not contain any disparaging comments on the international search report or the relevance of citations contained in that report. Reference to citations, relevant to a given claim, contained in the international search report may be made only in connection with an amendment of that claim.

Consequence if a demand for international preliminary examination has already been filed

If, at the time of filing any amendments and any accompanying statement, under Article 19, a demand for international preliminary examination has already been submitted, the applicant must preferably, at the time of filing the amendments (and any statement) with the International Bureau, also file with the International Preliminary Examining Authority a copy of such amendments (and of any statement) and, where required, a translation of such amendments for the procedure before that Authority (see Rules 55.3(a) and 62.2, first sentence). For further information, see the Notes to the demand form (PCT/ISPEA/401).

If a demand for international preliminary examination is made, the written opinion of the International Searching Authority will, except in certain cases where the International Preliminary Examining Authority did not act as International Searching Authority and where it has notified the International Bureau under Rule 66.1bis(b), be considered to be a written opinion of the International Preliminary Examining Authority. If a demand is made, the applicant may submit to the International Preliminary Examining Authority a reply to the written opinion together, where appropriate, with amendments before the expiration of 3 months from the date of mailing of Form PCT/ISA/220 or before the expiration of 22 months from the priority date, whichever expires later (Rule 43bis.1(c)).

Consequence with regard to translation of the international application for entry into the national phase

The applicant's attention is drawn to the fact that, upon entry into the national phase, a translation of the claims as amended under Article 19 may have to be furnished to the designated/elected Offices, instead of, or in addition to, the translation of the claims as filed.

For further details on the requirements of each designated/elected Office, see the *PCT Applicant's Guide*, Volume II.

NOTES TO FORM PCT/ISA/220

These Notes are intended to give the basic instructions concerning the filing of amendments under Article 19. The Notes are based on the requirements of the Patent Cooperation Treaty, the Regulations and the Administrative Instructions under that Treaty. In case of discrepancy between these Notes and those requirements, the latter are applicable. For more detailed information, see also the *PCT Applicant's Guide*, a publication of WIPO.

In these Notes, "Article," "Rule" and "Section" refer to the provisions of the PCT, the PCT Regulations and the PCT Administrative Instructions, respectively.

INSTRUCTIONS CONCERNING AMENDMENTS UNDER ARTICLE 19

The applicant has, after having received the international search report and the written opinion of the International Searching Authority, one opportunity to amend the claims of the international application. It should however be emphasized that, since all parts of the international application (claims, description and drawings) may be amended during the international preliminary examination procedure, there is usually no need to file amendments of the claims under Article 19 except where, e.g. the applicant wants the latter to be published for the purposes of provisional protection or has another reason for amending the claims before international publication. Furthermore, it should be emphasized that provisional protection is available in some States only (see *PCT Applicant's Guide*, Volume I/A, Annexes B1 and B2).

The attention of the applicant is drawn to the fact that amendments to the claims under Article 19 are not allowed where the International Searching Authority has declared, under Article 17(2), that no international search report would be established (see *PCT Applicant's Guide*, Volume I/A, paragraph 296).

What parts of the international application may be amended ?

Under Article 19, only the claims may be amended.

During the international phase, the claims may also be amended (or further amended) under Article 34 before the International Preliminary Examining Authority. The description and drawings may only be amended under Article 34 before the International Preliminary Examining Authority.

Upon entry into the national phase, all parts of the international application may be amended under Article 28 or, where applicable, Article 41.

When ? Within 2 months from the date of transmittal of the international search report or 16 months from the priority date, whichever time limit expires later. It should be noted, however, that the amendments will be considered as having been received on time if they are received by the International Bureau after the expiration of the applicable time limit but before the completion of the technical preparations for international publication (Rule 46.1).

Where not to file the amendments ?

The amendments may only be filed with the International Bureau and not with the receiving Office or the International Searching Authority (Rule 46.2).

Where a demand for international preliminary examination has been/is filed, see below.

How ? Either by cancelling one or more entire claims, by adding one or more new claims or by amending the text of one or more of the claims as filed.

A replacement sheet must be submitted for each sheet of the claims which, on account of an amendment or amendments, differs from the sheet originally filed.

All the claims appearing on a replacement sheet must be numbered in Arabic numerals. Where a claim is cancelled, no renumbering of the other claims is required. In all cases where claims are renumbered, they must be renumbered consecutively (Section 205(b)).

The amendments must be made in the language in which the international application is to be published.

What documents must accompany the amendments ?

Letter (Section 205(b)):

The amendments must be submitted with a letter.

The letter will not be published with the international application and the amended claims. It should not be confused with the "Statement under Article 19(1)" (see below, under "Statement under Article 19(1)").

The letter must be in English or French, at the choice of the applicant. However, if the language of the international application is English, the letter must be in English; if the language of the international application is French, the letter must be in French.